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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

## Application No.

10/634,635

## Applicant(s)

REYES, THOMAS D.

## Examiner

OJO O. OYEBISI

## Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC §101***

1. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-8 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

3. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions (*In re Bilski*), §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

4. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.

5. In this particular case, regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to another statutory class. Regarding the second

test, since the claimed subject matter may be performed using only human intelligence, the steps do not sufficiently transform the underlying subject matter to be statutory. Thus, to qualify as a 101 statutory method, the claim should positively recite the other statutory class (the thing or product) to which it is tied. For example, in this particular case, a 101 statutory method claim would be recited as follow: generating with **an image generator/computer** an image replacement document representative of the check by inserting the payment information into respective fields of the image replacement document template. In this particular example, the method step recited (i.e., generating an image replacement document....) is sufficiently tied to another statutory class, image generator or computer.

6. Claim 9-16 and 22-28 are also rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The rejected claims appear to be directed to computer program i.e., logic. Thus, software, programming, instructions, logic or code not claimed as encoded **on computer-readable media** are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional

interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory. Claim 9-16 and 22-28 are therefore rejected where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer. Examiner suggests that the applicant incorporate into the language of claims 9-16 and 22-28 that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as original filed does not provide support for the invention as now claimed i.e., determining the checking account of the particular account holder based on the payment information from the purchase transaction. The examiner searched the length and the breadth of the applicant's specification but failed to find a single paragraph where this limitation is stated. Clarification is required.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buttridge et al (Buttridge hereinafter, Pub No.: US 2004/0044606) IN VIEW OF Robinson et al (Robinson hereinafter, US PAT: 6978046).

**Re claim 1.** Buttridge further discloses a computerized method for effecting payment by a check, comprising: electronically receiving payment information for a check drawing on a checking account of an account holder, the payment information comprising a date, a payee, a dollar amount, a legal amount, and a signature in response to receiving the payment information (see col.2 paras 0012-0017), determining the checking account of the particular account holder based on the payment information from the purchase transaction (Buttridge discloses at the point of sale receiving a transaction amount and

the checking account information, see paras 0011. Inherently, Buttridge can use the received checking account information to determine the checking account of the particular account holder based on the payment information from the purchase transaction). Buttridge does not explicitly disclose, retrieving, from a storage location, storing a plurality of pre-stored image replacement document templates for each of a plurality of account holders, an image replacement document template associated with the checking account of the particular account holder used for the purchase transaction, the plurality of account holders comprising the particular account holder; and generating an image replacement document representative of the check by inserting the payment information into respective fields of the image replacement document template.

However, Robinson explicitly discloses an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check).

Thus it would have been obvious to one of ordinary skill in the art to combine the

teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 2. Buttridge further discloses electronically transmitting customer's data to a third party (see paras 0051). It should be noted that Buttridge does not explicitly disclose image replacement document. However, Robinson explicitly discloses creating an image replacement document. Thus, since image replacement document is just a form of data, and since Buttridge already teaches transmitting customer's data to a third party, it would have been obvious to one of ordinary skill in the art to use the device of Buttridge to electronically transmit the image replacement document created in Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 3. Buttridge explicitly discloses the computerized method of claim 2, wherein the third party is selected from the group consisting of a payor bank, a payee bank, and an account holder for the check (see paras 0051).

Re claim 4. Buttridge discloses the computerized method of claim 1, further comprising transmitting customer's data to a third party (see paras 0051). It should be noted that Buttridge does not explicitly disclose printing the image replacement document and transmitting a printed version of the image replacement document to a third party. However, Robinson discloses printing the image replacement document (see col.3 lines



42-50). Thus, since image replacement document is just a form of data, and since Buttridge already teaches transmitting customer's data to a third party, it would have been obvious to one of ordinary skill in the art to use the device of Buttridge to electronically transmit the image replacement document printed in Robinson to a third party so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 5. Buttridge further discloses the computerized method of claim 4, wherein the third party is selected from the group consisting of a payor bank, a payee bank, and an account holder for the check (see paras 0051).

Re claim 6. Buttridge further discloses the computerized method of claim 1, wherein the respective fields comprise a date field, a payee field, a dollar amount field, a legal amount field, and a signature field (see col.2 paras 0012-0017, see paras 0040)

Re claim 7. Buttridge does not explicitly disclose the computerized method of claim 1, wherein retrieving the image replacement document template comprises retrieving a name of the account holder, an address of the account holder, a routing and transit number, and an account number of the checking account. However, Robinson explicitly discloses wherein retrieving the image replacement document template comprises retrieving a name of the account holder, an address of the account holder, a routing and transit number, and an account number of the checking account (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention,

the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 8. Buttridge does not explicitly disclose the computerized method of claim 1, wherein generating the image replacement document representative of the check comprises: generating an image of a completed check; generating an image replacement document identification section; generating a legal notification section; and generating a MICR section representative of the MICR line of the check. However, Robinson explicitly discloses generating the image replacement document (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document

representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check).

Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 9. Buttridge further discloses Logic encoded in media for effecting payment by a check, the logic operable to perform the following steps: receive payment information for a check for a purchase transaction, the check drawing on a checking account of a particular account holder, the payment information comprising a date, a payee, a dollar amount, a legal amount, and a signature (see col.2 paras 0012-0017); in response to receiving the payment information: determine the checking account of the particular account holder based on the payment information from the purchase transaction (Buttridge discloses at the point of sale receiving a transaction amount and the checking account information, see paras 0011. Inherently, Buttridge can use the received checking account information to determine the checking account of the particular account holder based on the payment information from the purchase transaction. Buttridge does not explicitly disclose retrieve, from a storage location, storing a plurality of pre-stored image replacement document templates for each of a plurality of account holders, an image replacement document template associated with the checking account of the particular account holder used for the purchase transaction, the plurality

of account holders comprising the particular account holder; and generate an image replacement document representative of the check by inserting the payment information into respective fields of the image replacement document template. However, Robinson explicitly discloses an image replacement document template. Robinson further discloses generate an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 10. Claim 10 is a parallel of claim 2. That is to say it recites similar limitations to claim 2, and thus rejected using the same art and rationale as in claim 2 supra.

Re claim 11. Claim 11 is a parallel of claim 3. That is to say it recites similar limitations to claim 3, and thus rejected using the same art and rationale as in claim 3 supra.

Re claim 12. Claim 12 is a parallel of claim 4. That is to say it recites similar limitations to claim 4, and thus rejected using the same art and rationale as in claim 4 supra.

Re claim 13. Claim 13 is a parallel of claim 3. That is to say it recites similar limitations to claim 3, and thus rejected using the same art and rationale as in claim 3 supra.

Re claim 14. Claim 14 is a parallel of claim 6. That is to say it recites similar limitations to claim 6, and thus rejected using the same art and rationale as in claim 6 supra.

Re claim 15. Buttridge does not explicitly disclose the logic encoded in media of Claim 9, wherein the image replacement document template comprises a name of the particular account holder, an address of the account holder, a routing and transit number, and an account number of the checking account. However, Robinson explicitly discloses the creation of an image replacement document (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so

that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 16. Buttridge does not explicitly disclose the logic encoded in media of Claim 9, wherein the image replacement document comprises: an image of a completed check; an image replacement document identification section; a legal notification section; and a MICR section representative of the MICR line of the check. However, Robinson explicitly discloses the creation of an image replacement document (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 17. Buttridge further discloses a computerized method for effecting payment by a check, comprising: generating, on an output device, an electronic image of a check drawing on a checking account of an account holder; receiving payment information for the check on the output device (see col.3 paras 0031, also see fig.1 element 22); generating a snippet of the payment information (see paras 0041). Buttridge does not explicitly disclose electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet. However, The secondary reference, Robinson, further discloses electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 18. Buttridge further discloses the computerized method, wherein generating, on the output device, the electronic image of the check comprises: receiving a smart card at the output device and reading the smart card with the output device (see paras 0050). Buttridge does not explicitly disclose the smart card storing a check image template; and reading the stored check image template with the output device.

However, official notice is taken that it is old and well known in the art that smart cards do have memory that can store data/data images. Thus, as it is well known in the art, it would have been obvious to one of ordinary skill in the art to store the check image in a smart card. And since Buttridge output device is adapted to read smart card, the stored image can obviously be read by Buttridge's. One of ordinary skill in the art would have been motivated to do this in order to speed up the purchase transaction.

Re claim 19. Buttridge further discloses the computerized method of Claim 17, wherein receiving payment information for the check on the output device comprises receiving a date, a payee, a dollar amount, a legal amount, and a signature on the output device (see fig.7 element 747, also see paras 0040).

Re claim 20. Buttridge further discloses the computerized method of Claim 17, further comprising storing the snippet in a storage location (see fig.7 element 770).

Re claim 21. Buttridge further discloses the computerized method of Claim 17, wherein electronically transmitting the snippet to the remote location comprises electronically transmitting the snippet to a payee bank (see paras 0051).

Re claims 22. Buttridge further discloses Logic encoded in media for effecting payment by a check, the logic operable to perform the following steps: generate an electronic



image of a check drawing on a checking account of an account holder on an output device; receive payment information for the check on the output device (see col.3 paras 0031, also see fig.1 element 22); generate a snippet of the payment information (see paras 0041). Buttridge does not explicitly disclose electronically transmit the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet. However, Robinson explicitly discloses an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 23. Buttridge further discloses the logic encoded in media of Claim 22, wherein the logic is further operable to read a smart card associated with the account holder (see paras 0050). Buttridge does not explicitly disclose reading a check image template stored on a smart card associated with the account holder. However, official notice is taken that it is old and well known in the art that smart cards do have memory that can store data/data images. Thus, as it is well known in the art, it would have been obvious to one of ordinary skill in the art to store the check image in a smart card. And since Buttridge output device is adapted to read smart card, the stored image can obviously be read by Buttridge's. One of ordinary skill in the art would have been motivated to do this in order to speed up the purchase transaction.

Re claim 24. Buttridge further discloses the logic encoded in media of Claim 22, wherein the payment information comprises a date, a payee, a dollar amount, a legal amount, and a signature (see fig.7 element 747).

Re claim 25. Neither Buttridge nor Robinson further discloses the logic encoded in media of Claim 24, wherein the payment information is entered on the output device with a digital pen. However, official notice is taken that it is old and well known in the art that payment information is entered with a digital pen. Thus, it would have been obvious to one of ordinary skill in the art to incorporate this old and well known teaching into the combination of Buttridge and Robinson in order to speed up the purchase transaction.

Re claim 26. Buttridge further discloses the logic encoded in media of Claim 22, wherein the logic is further operable to store the snippet in a storage location (see fig.7 element 765).

Re claim 27. Buttridge further discloses the logic encoded in media of Claim 22, wherein the remote location is selected from the group consisting of a payee bank, a payor bank, and an image replacement document service provider (see paras 0051)

Re claim 28. Buttridge does not explicitly disclose the logic encoded in media of Claim 22, wherein the snippet comprises a file size of no more than about one kilobyte.

However, this limitation is descriptive, but not functional. And thus, carries no patentable weight.

Re claim 29. Buttridge further discloses a computerized method for effecting payment by a check, comprising: generating, on an output device, an electronic image of a check drawing on a checking account of an account holder; receiving payment information for the check on the output device, the payment information comprising a date, a payee, a dollar amount, a legal amount, and a signature (see col.3 paras 0031, also see fig.1 element 22), generating a snippet of the payment information (see paras 0041) ; electronically transmitting the snippet to a remote location (see paras 0051); electronically receiving the snippet at the remote location (see paras 0051). Buttridge does not explicitly disclose in response to receiving the snippet, retrieving, from a storage location, an image replacement document template associated with the checking account; and generating an image replacement document representative of the check by inserting the payment information from the snippet into respective fields of the image replacement document template. However, Robinson explicitly discloses an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into

respective fields of the image replacement document template (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 30. Claim 30 recites similar limitations to claim 18, and thus rejected using the same art and rationale as in claim 18 supra.

Re claim 31. Claim 31 recites similar limitations to claim 2, and thus rejected using the same art and rationale as in claim 2 supra.

Re claim 32. Claim 32 recites similar limitations to claim 4, and thus rejected using the same art and rationale as in claim 4 supra.

Re claim 33. Claim 33 recites similar limitations to claim 6, and thus rejected using the same art and rationale as in claim 6 supra.

Re claim 34. Claim 34 recites similar limitations to claim 7, and thus rejected using the same art and rationale as in claim 7 *supra*.

Re claim 35. Claim 35 recites similar limitations to claim 8, and thus rejected using the same art and rationale as in claim 8 *supra*.

### **Response to arguments**

Applicant's arguments filed 11/06/2008 have been fully considered but they are not persuasive. The examiner argues in substance that claims 1, 17 and 29 are sufficiently tied to a particular machine and thus are statutory. The examiner concurs that claims 17 and 29 are sufficiently tied to another statutory class i.e., an output device, and thus these claims are statutory. The rejections of claims 17-21, and 29-35 under 35 U.S.C 101 are hereby withdrawn. The examiner totally disagrees with the applicant's assertion that the method claim 1 is sufficiently tied to another statutory class. The preamble of claim 1 recites "a computerized method for effecting payment...." However, nowhere in the body of the claim does it state that the recited method steps are tied to a particular machine. Thus, the examiner maintains the rejection of claims 1-8 under 35 U.S.C 101.

The applicant further argues that the limitation, "determining the checking account of the particular account holder based on the payment information from the purchase transaction", recited in claims 1 and 9, complies with the written description requirement. The examiner asked the applicant for a paragraph in applicant's disclosure that provided support for the above mentioned claimed limitation. The applicant then pointed to Figure 6, page 4, lines 2-14; page 12, line 14 - page 13, line 6; and page 13, line 22 - page 14, line 8 of Applicant's Specification for providing support for the stated limitation herein above. However, no

where in these figures and pages did the examiner find the claimed limitation “determining the checking account of the particular account holder based on the payment information from the purchase transaction.” Thus the examiner maintains the rejection of claims 1-16 under 35 U.S.C. 112, first paragraph.

The applicant further argues in substance that the combination of *Buttridge and Robinson* fails to disclose/teach the following limitations recited in Claim 1: determining the checking account of the particular account holder based on the payment information from the purchase transaction, retrieving, from a storage location, storing a plurality of pre-stored image replacement document templates for each of a plurality of account holders, an image replacement document template associated with the checking account of the particular account holder used for the purchase transaction, the plurality of account holders comprising the particular account holder; and generating an image replacement document representative of the check by inserting the payment information into respective fields of the image replacement document template. Contrary to the applicant’s assertion, Buttridge discloses that at the point of sale receiving a transaction amount and the checking account information, see paras 0011. Inherently, Buttridge can use the received checking account information to determine the checking account of the particular account holder based on the payment information received from the purchase transaction. Further, the secondary reference, Robinson explicitly discloses an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template (i.e., The systems and methods according to this invention allow the scan/preparation user

generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design theme of the document, see col.2 lines 50-62, also see “Once the attributes of the objects are identified, a template containing the attributes is synthesized. Once created, the template is saved in any desired template format for use with word processing software or the like. The template can then be used to create additional/replacement pages for the existing document that are visually coherent with the predetermined visual design theme of the document,” Robinson, col.3 lines 7-14 ). The examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check. The examiner further contends that Robinson can create a document template from a scanned input document and then use the template to create additional/replacement pages for the existing scanned input document. Thus since date, payee name, a dollar amount, a legal amount, and a signature are all data elements/information on a document/check, and since Robinson can scan input document for the creation of document template, Robinson can certainly scan all data elements/information on a document/check (i.e., date, payee name, a dollar amount, a legal amount, and a signature) for the creation of a replacement document template. In response to applicant's argument that the examiner fails to establish a *prima facie* case of obviousness based on the proposed Buttridge-Robinson combination, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However,

the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971), references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this particular case, the examiner expressly provides motivation for the combination of Buttridge-Robinson references. That is to say, with respect to claim 1, one of ordinary skill in the art would have been motivated to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

The applicant further argues that the proposed combination of Buttridge and Robinson fails to teach: generating a snippet of the payment information; electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet; electronically receiving the snippet at a remote location; and generating an image replacement document representative of the check by inserting the payment information from the snippet into respective fields of the image replacement document template. Contrary to the applicant's assertion, Buttridge discloses generating a snippet of the payment information and receiving the snippet at a remote location (i.e., after the two outputs are transferred and stored in the data storage units, e.g., on the hard drive of the store controller and/or central controller, the store controller sends a completion message to the cash register indicating the end of the transaction, at 170. Alternatively, the cash register may send the transaction and image data to the store



controller and the store controller then **generates and forwards the required data to the batch data storage unit and to the authorization data storage unit**, see paras 0041).

First, the authorization data storage unit is a remote location and the required data that is generated and forwarded to the third party authorization storage unit, taught by Buttridge, is akin to the applicant's claimed snippet of the payment information being generated and received. The secondary reference, Robinson, discloses electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet and generating an image replacement document representative of the check by inserting the payment information from the snippet into respective fields of the image replacement document template (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). The examiner further contends that Robinson can create a document template from a scanned input document and then use the template to create additional/replacement pages for the existing scanned input document.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

/O. O. O./  
Examiner, Art Unit 3696

**Application Number****Application/Control No.**

10/634,635

**Applicant(s)/Patent under  
Reexamination**

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OJO O. OYEBISI

**Art Unit**

3696